

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCE

Appellants: Timothy P. Tully, Joshua I. Dubnau, Michael Davis, Jan Mous  
and Ulrich Certa

Application No.: 09/523,066 Group Art Unit: 1634

Filed: March 10, 2000 Examiner: B.J. Forman

Confirmation No.: 4462

For: GENE CHIP TECHNOLOGY FOR DETERMINING MEMORY GENES

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REPLY TO OFFICE COMMUNICATION  
CONCERNING DECLARATION UNDER 37 C.F.R. § 1.132

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Sir:

This Reply to Office Communication is submitted in response to the Office communication mailed from the U.S. Patent and Trademark Office on June 4, 2004 in the above-referenced patent application.

In the Office communication, the Examiner alleges that Appellants have not met the requirements of 37 C.F.R. 1.195 because Appellants have "not provided a showing of good and sufficient reasons why the Declaration under 37 C.F.R. 1.132 was not presented earlier."

Appellants respectfully disagree with this assessment.

Appellants provided a showing of good and sufficient reasons in the Amended Brief on Appeal filed October 17, 2003 as to why the Declaration of Timothy P. Tully under 37 C.F.R. § 1.132 had not been submitted earlier during prosecution of the subject application.

In particular, Appellants had set forth the following reasons in the Amended Brief regarding why the Declaration had not been submitted earlier during prosecution of the subject application:

1. Appellants had explained the teachings of the Yin *et al.* reference during the course of prosecution and had not anticipated that the Examiner would continue to disagree with Appellants' explanation of those teachings. At page 6, lines 14-20 of the Amended Brief, Appellants state that the Declaration was filed in view of the Examiner's continued disagreement with Appellants' explanation of the teachings of the Yin *et al.* reference and in further support Appellants' assessment of the teachings of the Yin *et al.* reference. That is, the Declaration was filed to provide evidence that rebuts the Examiner's characterization of the teachings of the Yin *et al.* reference.

2. Appellants had explained the teachings of the Tully *et al.* patent during the course of prosecution and had not anticipated that the Examiner would continue to disagree with Appellants' explanation of those teachings. At page 8, lines 11-16 of the Amended Brief, Appellants state that the Declaration was filed in view of the Examiner's continued disagreement with Appellants' explanation of the teachings of the Tully *et al.* patent and in further support Appellants' assessment of the teachings of the Tully *et al.* patent. That is, the Declaration was filed to provide evidence that rebuts the Examiner's characterization of the teachings of the Tully *et al.* patent.

3. Appellants had explained the teachings of the Ramsey reference during the course of prosecution and had not anticipated that the Examiner would continue to disagree with Appellants' explanation of those teachings. At page 9, lines 3-7 of the Amended Brief, Appellants state that the Declaration was filed in view of the Examiner's continued disagreement with Appellants' explanation of the teachings of the Ramsey reference and in further support Appellants' assessment of the teachings of the Ramsey reference. That is, the Declaration was filed to provide evidence that rebuts the Examiner's characterization of the teachings of the Ramsey reference.

4. During the course of prosecution, Appellants had also explained why the invention of Claims 11-13, 15 and 24-26 is nonobvious over the cited references and their combined teachings. Appellants had not expected that the Examiner would continue to disagree with Appellants' arguments. As indicated at page 13, lines 1-3 of the Amended Brief, the Declaration of Dr. Tully was submitted in further support of Appellants' position. That is, the Declaration was filed to provide evidence that refutes the Examiner's determination that the invention of Claims 11-13, 15 and 24-26 is obvious over the cited references and their combined teachings. For example, in Section 6 of the Declaration, Dr. Tully states that the subject application teaches a specific set of microarray comparisons that can be used to identify downstream genes which are specifically regulated during long-term memory formation, and upon which an appropriate statistical method may be performed. Dr. Tully states that this combination of methods (comparison of particular behavioral training protocols and statistical method) is not disclosed by the cited combination of references.

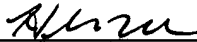
#### CONCLUSION

Appellants have provided a showing of good and sufficient reasons in the Amended Brief on Appeal filed October 17, 2003 as to why the Declaration of Timothy P. Tully under 37 C.F.R. § 1.132 was not submitted earlier during prosecution of the subject application.

Reconsideration and entry of the Declaration are requested.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

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